

REMARKS

Upon entry of the present amendments, claims 1-31 will be pending in the above-identified application. Claims 32-36 have been canceled without prejudice or disclaimer. Claims 1, 21-24, and 26 have been amended to incorporate elements previously present in dependent claims 32-36. As such, no new matter is added by these amendments.

It is submitted that the amendments do not require a new search or consideration because the amendments merely clarify the claimed subject matter or include elements already present elsewhere in previously pending claims. An noted above, claims 1, 21-24, and 26 have been amended to include elements from previously pending dependent claims 32-36 and, therefore, do not change the subject matter under consideration or require a new search. The amendments do not add more claims than were finally rejected and, it is submitted, place the claims in condition for allowance, or in better condition for appeal. As such, it is respectfully requested that the amendments be entered.

Applicants gratefully acknowledge the telephone discussion with the Examiner taking place 11/8/2006, during which Applicants pointed out that previously pending claims 32-36 included elements that were not identified by the Examiner as being taught or suggested by the cited Jones reference (see below) or elsewhere in the art.

Rejections Under 35 U.S.C. §102

Claims 1-36 are rejected under 35 U.S.C. §102(e) as being clearly anticipated by *Jones et al.* (U.S. Patent No. 6,409,504).

While Applicants do not agree with the rejections or acquiesce to any reasoning set forth by the Examiner, the claims have been amended in order to advance prosecution of the present case. For example, claim 1, as amended, is directed to a computer-implemented method for separating gingiva from a tooth on a computer model of the gingiva and the tooth, the method comprising: defining a closed cutting surface passing through a line between the gingiva and a crown of the tooth, wherein the closed cutting surface comprises a crown portion surrounding the crown of the tooth and a root portion approximating the shape of the root of the tooth, and

wherein the crown portion of the closed cutting surface comprises a volume greater than the volume of the crown of the tooth; and applying the cutting surface to the tooth to separate the gingiva from the tooth.

Applicants initially note, as stated above, that the present claims 1, 21-24, and 26 have been amended to merely incorporate elements that had previously been presented in dependent claims 32-36, and which have not been identified by the Examiner as being taught or suggested in Jones or elsewhere. Claims 32-36 have been canceled herein without prejudice or disclaimer.

Applicants respectfully submit that Jones fails to teach each and every element of the currently claimed invention, thereby precluding a finding of anticipation under 35 U.S.C. §102(e). In particular, Jones at a minimum fails to teach defining a closed cutting surface, wherein the closed cutting surface comprises a crown portion surrounding the crown of the tooth and a root portion approximating the shape of the root of the tooth, and wherein the crown portion of the closed cutting surface comprises a volume greater than the volume of the crown of the tooth. These elements, which are missing from Jones, are recited in independent claims 1, 21-24, and 26, and incorporated into corresponding dependent claims 2-20, 25, and 27-31. Moreover, these elements are supported throughout the specification (see, e.g., Figures 6, 8B, 11, and 12). The Examiner's attention is respectfully drawn, for example, to the exemplary embodiment illustrated Figure 6 and the corresponding discussion in the detailed description at page 13, paragraph [0065], which illustrates a cutter shaped like a sort of "ice-cream cone", with the top surrounding the crown of a tooth to be extracted, and the bottom embedded inside the gingival to define the root of the tooth. These elements recited in the current claims are not taught or suggested by Jones.

Accordingly, Applicants respectfully request withdrawal of the rejections of claims 1-31 under 35 U.S.C. § 102(e).

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

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